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From: Sharon Shelton
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Date: March 5, 2007

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To: USPTO
Attn: Examiner Michael Bekerman

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Confirmation No.

No. of Pages (including this cover page) ELEVEN (11)

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Message: DELIVER TO EXAMINER BEKERMANN

Applicant : Graham, et al.
Filed : August 31, 2001
Serial No. : 09/945,378
Title : COMPUTERIZED SYSTEM AND METHOD FOR PROVIDING ADVERTISING
TO A CONSUMER
Docket No. : CRG03-GN003
Examiner : Bekerman, Michael
Art Unit : 3622

See attached PRE-APPEAL BRIEF REQUEST FOR REVIEW, including NOTICE OF APPEAL Form PTO/SB/31, to be filed in the above-referenced matter.

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PTO/SB/17 (02-07)

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**
For FY 2007☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 510.00

Complete if Known

Application Number	09/945,378
Filing Date	08-31-2001
First Named Inventor	Graham, et al
Examiner Name	Bekerman, M.
Art Unit	3622
Attorney Docket No.	CGR03-GN003

METHOD OF PAYMENT (check all that apply)

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☒ Deposit Account Deposit Account Number: 50-3072 Deposit Account Name: TAFT STETTINIUS & HOLLIST

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)

Total Claims Extra Claims Fee (\$) Fee Paid (\$)

- 20 or HP = x =

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)

- 3 or HP = x =

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(g).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)

- 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(S)

Non-English Specification. \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): (2253) 3-MO EXTN FEE

Fees Paid (\$)

510.00

SUBMITTED BY

Signature

Registration No.

48,787

Telephone 513-357-9663

Name (Print/Type) RYAN L WILLIS

Date 03-05-2007

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Sharon Shelton**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:

Applicant : Graham, et al.
Filed : August 31, 2001
Serial No. : 09/945,378
Title : COMPUTERIZED SYSTEM AND METHOD FOR
PROVIDING ADVERTISING TO A CONSUMER
Docket No. : CGR03-GN003
Examiner : Bekerman, Michael
Art Unit : 3622

Hon. Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The present submission is in response to the Advisory Action of February 5, 2007 and the Office action of September 6, 2006, and having a period of response with a three-month extension of time extending through and including March 6, 2007.

The following remarks comprise the five (5) pages provided for by the Pre-Appeal Brief Conference Pilot Program. See July 12, 2005 Official Gazette.

Applicants respectfully request revocation of the rejections and objections of record. In sum, the instant grounds of rejection and objection are not supported by applicable law or the record.

No amendments are being filed with this request.

03/06/2007 CCHAU1 00000101 503072 09945378

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REMARKS

Introductory Comments

Claims 33-49 and 64-70 comprise the subject matter for which review is requested. Claims 33-37, 42, 44-49 and 64-70 stand rejected as being allegedly obvious over U.S. Patent No. 6,764,395 ("Guyett") in view of U.S. Pub. No. 2003/0191690 ("McIntyre"). This rejection is in err, most notably as the cited art fails to disclose all of Applicants' claimed limitations. Claims 38-41 and 43 stand rejected as being allegedly obvious over U.S. Patent No. 6,764,395 ("Guyett") in view of U.S. Pub. No. 2003/0191690 ("McIntyre"), in further view of U.S. Patent No. 5,679,075 ("Forrest"). This rejection is also in err, most notably as the cited art fails to disclose all of Applicants' claimed limitations.

35 U.S.C. § 103 Rejections

Claims 33-37, 42, 44-49 and 64-70 are rejected as being allegedly obvious over Guyett in view of McIntyre. This ground of rejection should be reversed, most notably as the rationale upon which the rejections are premised does not meet the statutory and judicial threshold for showing a *prima facie* case of obviousness.

Claims 33/67 require the following three steps (in addition to the other steps recited in each respective claim):

- gathering data associated with the consumer's interactions with the present interactive advertising message/computerized game;
- generating a statistical report from the data; and
- providing the statistical report to the commercial entity

On page 7 of the final Office action it is admitted that Guyett does not specify generating a statistical report and sending it to the commercial entity as claimed by claims 33 and 67. However the final Office action argues that McIntyre "teaches a statistical report that keeps track of how many times a game is played and the sending of this report to sponsors of the game (Paragraph 0008)." This interpretation of McIntyre is incorrect.

McIntyre only discloses a computer game where advertising images of various sponsors are provided to the game, where the game system keeps track of the use of the advertising

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images so that the sponsors can be appropriately billed. The process of McIntyre cited by the final Office action is explained in slightly more detail in paragraph [0042] of McIntyre:

The host server may keep track of the number of times the games are played and to which sponsor the game is being played. In another form of the present invention, the games may be dispensed by the host server 26 in accordance with a predetermined schedule. Thus keeping track of the number of times a sponsor message contest and/or message is received. This also allows a sponsor to be billed for the actual number of times games have been played on their behalf.

In other words, McIntyre neither discloses the generation any statistical report as claimed, nor does it disclose the step of providing that statistical report to the commercial entity as claimed. At best McIntyre discloses a step of billing a sponsor according to the number of times a sponsor's advertising is displayed.

This is significant for several reasons. First, a billing amount of McIntyre is not a statistical report as claimed; second, the billing amount of McIntyre is only processed based upon the number of times a sponsor's advertising is displayed, rather than the data associated with the consumer's interactions with the present interactive advertising message/computerized game as claimed; and third, McIntyre does not even disclose a step of sending a bill, a report, or anything similar to the commercial entity — the final step of "providing the statistical report to the commercial entity" as claimed is completely absent.

Consequently, even if Guyette and McIntyre were combined as argued by the final Office action, one of ordinary skill still would not be motivated to reach the invention as claimed in claims 33/67 because neither reference discloses: (a) generating a statistical report from the data [associated with the consumer's interactions with the present interactive advertising message/computerized game]; or (b) providing the statistical report to the commercial entity.

In an apparent attempt to compensate for the failings of the prior art, the Examiner makes an unsubstantiated argument that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide a report to the commercial entity. This would aid the commercial entity in knowing how well-received their game is." Applicant respectfully disagrees and traverses this argument.

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Significantly, neither Guyett nor McIntyre provide any indication whatsoever of the *market-research* functionality and purpose of the invention as claimed in claims 33 and 67. Guyett only collects data associated with consumer's interactions to a computer payoff or prize to the consumer (referring to col. 10, lines 17-20 as cited by the final Office action); and, as discussed, above, McIntyre does not even disclose collecting data associated with consumer interactions at all, but counts the number of ads provided to a game, on behalf of a sponsor, to calculate a bill to that sponsor. It's no wonder, then, that neither of these references discloses the claimed steps of generating and providing the statistical report as claimed. Certainly, while such market-research uses of the interactive advertising message/computerized game of the present invention may seem advantageous *in hindsight*, they were clearly not recognized by either Guyett nor McIntyre. Thus, one of ordinary skill at the time of the invention, would certainly not see the need to modify either or both of Guyett or McIntyre as suggested by the Examiner. While it may seem apparent to the Examiner in hindsight that providing a report to the commercial entity would "aid the commercial entity in knowing how well-received their game is," the Examiner has pointed to nothing in the prior art to substantiate this subjective statement in any way. Consequently, for at least the above reasons, it is respectfully submitted that independent claims 33 and 67 are allowable over the combination of Guyett and McIntyre.

Claims 34-49 and 64-66 depend from claim 33 and claims 68-70 depend from claim 67; and therefore, and is respectfully submitted that these claims are allowable for at least the same reasons as given above for claims 33 and 67.

Additionally, with respect to claims 44 and 46-49, the Office action admits that Guyett does not specify that the game gathers data related to brand type, tag lines, product benefits, imagery, and communication language in particular. The Office action takes Official Notice, and the Applicant now agrees, that it is old and well known that advertisements frequently contain brand type, tag lines, product benefits, imagery, and communication language. But then the final Office action argues that it would have been, therefore, allegedly obvious to one having ordinary skill in the art at the time of the invention was made to gather information related not only to advertisements in general, but also related to the above categories, because "this would allow the advertiser to understand more about how their product is doing in the marketplace." For much the same reasons as given above for claims 33 and 67, the Applicant respectfully disagrees.

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Each of the categories of information gathered by claims 44 and 46-49 and missing in Guyett are relevant to the market-research aspect of these claims. As discussed above, both Guyett and McIntyre fail to recognize a market-research purpose or benefit. Thus, simply because such categories of data may be present in many forms of advertisements, this certainly does not mean that there exists any teaching or motivation in either Guyett nor McIntyre to gather or process such data. While such a step might be advantageous in subjective hindsight, the Examiner has not shown anything in the prior art that the advertiser even wished to understand how their brand type, tag lines, product benefits, imagery and communication language were being understood or recognized by the ad-viewers/game-players. As mentioned above, Guyett collected data to determine a prize amount to the player and McIntyre collected data to calculate a bill. Consequently, it is respectfully submitted that claims 44 and 46-49 are allowable for at least these additional reasons.

Additionally, with respect to claims 64-66/68-70, claims 65/68 recite that the statistical report of claims 33/67 will illustrate a number of first-time accesses of consumers to the interactive advertising message over a period of time, while claims 66/69 recite that the statistical report of claims 33/67 will illustrate a comparison of consumers who were able to identify the commercial entity's logo, trademark, trade name, tag line, and/or product name verses a competitor's logo, trademark, trade name, tag line, and/or product name, and claims 66/70 recite that the statistical report of claims 33/67 will illustrate information related to the consumer's interaction time with the interactive advertising message. The final Office action appears to agree that neither Guyett nor McIntyre discloses such data content in any statistical report, but then argues, citing In re Gulack and In re Lowry, that such differences are "only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability..." The Applicant respectfully disagrees.

Each of the recited steps of claims 64-66 and 68-70 are functionally related and involved with the statistical report itself and with the recited step, in claim 33/67, of "gathering data associated with the consumer's interactions with the present interactive advertising message." Thus, claims 64-66 and 68-70 are very much like the claims that the Federal Circuit found

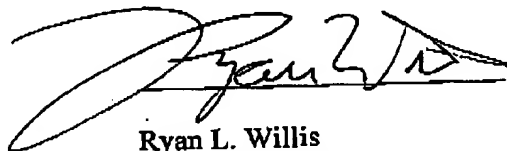
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patentable in In re Gulack. In In re Gulack, the invention-at-issue consisted of: (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed. The rejection by the PTO was premised upon the fact that a circular band with items printed upon it was well known in the art. The Federal Circuit *reversed*, finding that the numbers printed on the band had a functional relationship to the band itself. Similarly, in the present case, the material printed on the statistical report has a functional relationship to the statistical report itself and to the method for generating the statistical report. Consequently, the rejection of claims 64-66 and 68-70 is traversed for at least this additional reason.

Conclusion

In light of the foregoing, it is respectfully submitted that claims 33-49 and 64-70 are patentably distinct from the references cited and are in condition for allowance.



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